

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

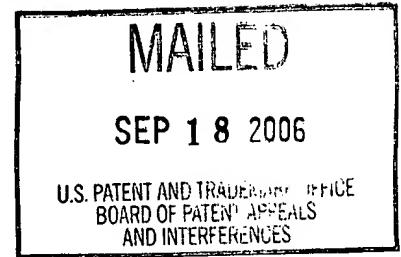
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAY C. HSU, ED ROSENTHAL,
RICHARD L. SHICK, and AUDRA S. WRIGHT

Appeal No. 2006-2907
Application No. 09/718,071

ON BRIEF



Before ADAMS, GRIMES, and LEBOVITZ, Administrative Patent Judges.

LEBOVITZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to an absorbent paper product for drying and conditioning the skin. The examiner has rejected the claims as obvious over prior art. We have jurisdiction under 35 U.S.C. § 134. We reverse.

Background

The application describes paper products that can be utilized to dry and condition the skin. Specification, page 1, lines 19-21. The products contain a lotion at "relatively low add-on levels" which enables them to condition the skin, while retaining their absorbent properties. Id., page 3, lines 11-25. When utilized to dry the skin after

washing, the products are described to impart “certain benefits to the skin, such as inhibiting microbial growth, skin disease, [and] skin dryness.” Id., page 3, lines 22-25. The lotion contains water-soluble skin conditioning and viscosity modifier components. Id., page 1, lines 22-26.

Claims 1-4, 7-17, 19-22, 24-27, 29, 44, and 45 are on appeal. We select claim 1 as representative.

1. An absorbent paper product for drying and conditioning the skin of a user, wherein the paper product is in the form of a towel, wipe, or napkin, said paper product comprising:

a paper web; and

a water-soluble lotion composition applied to said paper web such that the add-on level of said lotion composition is between about 1% to about 10% by weight of said paper product, said lotion composition comprising:

i) water in an amount between about 10% to about 90% by weight of said lotion composition;

ii) a water-soluble skin conditioning component, said water-soluble skin conditioning component including glycerin in an amount between about 2% to about 15% by weight of said lotion composition; and

iii) a viscosity-increasing component in an amount between about 2% to about 10% by weight of said lotion composition, said viscosity-increasing component including at least one alkoxylated alcohol surfactant.

Discussion

Obviousness under 35 U.S.C. § 103

Claims 1-4, 7-17, 19-22, 24-27, 29, 44, and 45 stand rejected 35 U.S.C. § 103 as unpatentable over Hammonds¹ in view of Sebillotte-Arnaud² and Potini³.

¹ Hammonds et al. (Hammonds), WO 98/03147, published Jan. 29, 1998.

² Sebillotte-Arnaud, U.S. Pat. No. 5,728,389, issued Mar. 17, 1998.

³ Potini, U.S. Pat. No. 4,944,938, issued Jul. 31, 1990.

Hammonds describes fibrous sheet materials, such as wet wipes, which contain oat extract. Hammonds, page 1, lines 5-10. The addition of oat extract to wet wipes results in a paper product having an improved soothing effect on skin. Id., page 1, lines 23-30. The oat extract solution can comprise the following components: 1) about 0.5-50 weight % of oat extract; and 2) about 10-90 weight % of a solubilizing agent. Id., page 1, lines 34-page 2, line 2. The solubilizing agents that can be included in the composition are listed as butylene glycol, propylene glycol, dipropylene glycols, glycerols, and aqueous sorbitols. Id., page 5, lines 15-24. The oat extract can also include about 0.25-5.0 weight % of a surfactant “to aid in skin cleansing.” Id., page 2, lines 11-12. The surfactants can include anionic and amphoteric surfactants. Id., page 4, line 34-page 5, line 3.

Sebillotte-Arnaud describes a skin cleaning composition that has a deformable solid appearance and a marshmallow consistency. Sebillotte-Arnaud, column 1, lines 54-57; column 2, lines 18-22. To achieve this consistency, it contains a structuring agent formed of solid particles. Id., Abstract; column 1, lines 60-66. The solid particles are preferably made of thermoplastic materials. Id., column 3, lines 15-20. In addition to the structuring agent, the composition contains agents conventionally used in skin cleaning compositions, such as cleansing and/or foaming surfactants. Id., column 4, lines 25-65.

Potini is directed to a “non-alcoholic, quick drying, highly active, antiperspirant and deodorant gel.” Potini, column 1, lines 45-47. Aluminumchlorhydrate and a volatile water insoluble emollient are required in the gel. Id., column 2, lines 5-20. A water-

soluble thickener can also be present, such as talloweth-60 myristyl glycol. Id., lines 60-64.

The claims were rejected as obvious over Hammonds in view of Sebillotte-Arnaud and Potini. According to the examiner, the only difference between the claimed subject matter and Hammonds, was the latter's failure to teach "alkoxylated alcohol surfactants" as recited in claim 1. Answer, page 4. This deficiency, the examiner argued, was supplemented by Sebillotte-Arnaud and Potini, each which describe the alkoxylated surfactant, talloweth-60 myristyl glycol, in a cosmetic. Id. The motivation to have added talloweth-60 myristyl glycol to Hammonds's composition was summed up as follows:

1) Hammonds teaches to include suitable cosmetic ingredients such as additional surfactants in the aqueous liquid to provide the desired wiping properties; 2) Sebillotte-Arnaud teaches that talloweth-60 myristyl glycol is an old and well known nonionic surfactant used in a skin cleanser; 3) Potini teaches that talloweth-60 myristyl glycol is also used as a water-soluble thickener in cosmetic art.

Id., paragraph spanning pages 4-5.

Appellant argued that there was no motivation or suggestion to have a selected at least one alkoxylated alcohol surfactant as required by the claim. Brief, page 5.

We do not find ourselves in agreement with the examiner's position. The examiner bears the initial burden of showing unpatentability. See e.g., In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion

to select and combine the references relied on as evidence of obviousness." In re Sang Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

First, we turn to the evidence of obviousness put forward by the examiner. The Hammonds application was cited for its core teaching that surfactants can be included in a wet wipe. However, claim 1 is not directed to just any surfactant, but specifically requires an alkoxylated⁴ alcohol surfactant. For this reason, it is necessary to dig deeper into Hammonds' disclosure to determine whether it reasonably suggests, in combination with Sebillotte-Arnaud and Potini, an alkoxylated alcohol surfactant. According to Hammonds, suitable surfactants include "anionic surfactants ... amphoteric surfactants and the like." Hammonds, page 4, line 34-page 5, line 1. See also id., page 8, lines 11-16. Talloweth-60 myristyl glycol, the alkoxylated surfactant identified in the prior art by the examiner, is characterized by Sebillotte-Arnaud as a "non-ionic surfactant." Sebillotte-Arnaud, column 6, lines 55-57. In our view, to choose a non-ionic surfactant, when Hammonds suggests anionic and amphoteric forms, would require the skilled worker to step off the path followed by Hammonds.

The surfactant disclosure by Sebillotte-Arnaud is also inadequate to establish prima facie obviousness. At column 4, lines 39-65, Sebillotte-Arnaud lists cleansing surfactants suitable for its skin cleansing composition. Talloweth-60 myristyl glycol is specifically utilized in Example 3 at column 6. The examiner stated that the motivation to have used it in the Hammonds wipe was "due to the known cleansing property" of talloweth-60 myristyl glycol. Answer page, 8. However, this reasoning improperly

⁴ An "alkoxy" is an alkyl radical attached to a molecule by oxygen, such as an ethoxy radical. McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition, McGraw-Hill, Inc., 1978, page 51.

“import[s] hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components.” Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337, 75 USPQ2d 1051, 1054 (Fed. Cir. 2005). Virtually all inventions are a combination of old elements. Id. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-1317 (Fed. Cir. 2000). Hammonds teaches the use of surfactant cleansers in its wet wipe products, but to establish the obviousness of incorporating the talloweth-60 myristyl glycol surfactant, there must be more than mere encyclopedic knowledge of its properties.

The examiner’s argument appears to be built on the premise that surfactants are interchangeable, and that such knowledge would have motivated a person skilled in the art to modify the Hammonds composition to include an alkoxylated alcohol surfactant. Our problem with this reasoning is two-fold. First, we do not find evidence in the record that establishes the equivalence between surfactants. Absent this information, the examiner has not satisfied her burden to establish the requisite motivation, suggestion, or teaching to have modified Hammonds with the additional prior art relied upon in the rejection. See e.g., Abbott Labs. v. Andrx Pharmaceuticals, 452 F.3d 1331, 1340-42, 79 USPQ2d 1321, 1328-29 (Fed. Cir. 2006) where evidence of interchangeability was considered a substantial argument that a person of ordinary skill in the art would be motivated to combine the prior art references. Secondly, as discussed above, the Hammonds application leads in a different direction. Its disclosure of using two specific

surfactant classes, with mention of "particularly suitable" examples, would not have been recognized, in our opinion, by a person of ordinary skill of art as teaching that all surfactants are interchangeable. Hammonds, page 8, line 14.

The combination of Hammonds with Potini and Sebillotte-Arnaud is also inadequate to establish a case of prima facie obviousness. Potini characterizes talloweth-60 myristyl glycol as a thickener that may be included in an antiperspirant and deodorant gel. Potini, column 2, lines 60-65. However, there is no evidence in the record to establish the motivation to have incorporated a thickener into the fibrous materials disclosed in Hammon.

We also cannot find mention in Hammonds of adding thickeners or viscosity-enhancers to the water-soluble oat extract solution that would have reasonably suggested talloweth-60 myristyl glycol. The examiner has improperly used "hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1371, 56 USPQ2d 1065, 1072 (Fed. Cir. 2000) (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)).

For the foregoing reasons, it is our opinion that the examiner failed to provide the evidence necessary to establish a prima facie case of obviousness. Accordingly, we reverse the rejection of claims under 35 U.S.C. §103 as being unpatentable over the combination of Hammonds in view of Sebillotte-Arnaud and Potini.

Summary

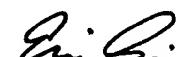
The rejection of the claims over prior art is reversed.

REVERSED



Donald E. Adams
Administrative Patent Judge

)
)
)



Eric Grimes
Administrative Patent Judge

) BOARD OF PATENT
)
) APPEALS AND



Richard M. Lebovitz
Administrative Patent Judge

) INTERFERENCES
)
)

RL/dym

Jason W. Johnston
Dority & Manning, P.A.
PO Box 1449
Greenville, SC 29602-1449